

## REMARKS

### Summary

Claims 1, 3, 8 and 10 were pending and all of the claims were rejected in the present Office action; Claim 1 has been amended. No new matter has been added.

### Claim Rejections

#### **35 U.S.C. § 102 (b)**

Claims 1, 3, and 8-10 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Davidson (US 6,400,576; "Davidson").

The Examiner asserts that "an array of capacitive elements 190 (col 7:34-54) at least partially surround[s] the electrical device (beneath the IC 40)". The Applicants respectfully submit that Davidson teaches that there is a package 40 for the IC, which is mounted within an opening 150 in a socket 120 (Davidson, col. 6, lines 24-29), and that the capacitors 190 are mounted in the socket 120 (see FIG. 2). As such the capacitors 190 are not part of the package 40 to which the IC is mounted. Thus, Davidson does not teach the arrangement of Claim 1, where the capacitive elements are part of a multilayer board, and the claim is not anticipated.

Since Davidson fails to disclose the all of the features of Claim, the claim is allowable over the reference. Withdrawal of the rejection is respectfully requested.

Claims 3 and 8-10 are allowable as claims dependent on an allowable claim. The claims are also independently allowable. For example, with respect to Claim 8, the Examiner asserts that Davidson discloses "a characteristic (capacitance) of the capacitive elements in the array changes with a distance from the electrical device." However, Davidson merely teaches that differing values of capacitance may be used (Davidson col. 7, lines 34-54), and is silent on the variation of the capacitance of a capacitor of the capacitor array with respect to a distance from the electrical device. As such, Davidson does not teach the subject matter of Claim 8.

Regarding Claims 9 and 10, the Examiner asserts that Davidson discloses "the capacitive elements having different capacitance, therefore it is inherent that the

conductive plates of the capacitors (conductive layers, patches, pads or electrodes, see claim 3 above) are also changed in size and effectively to the shape of the plates (patches)".

Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). [emphasis added].

The capacitors 190, which may have different values, are shown in FIG. 4 as having the same size. It is well known in the art that a variety of capacitance values may be had in a package of the same standard size, and therefore that the size of capacitor package or a component thereof is not necessarily changed to achieve different capacitance values. As such, the Applicants respectfully submit that the asserted inherent property does not exist.

Claims 1, 3, and 8-10 were also rejected under 35 U.S.C. § 102 (b) as being anticipated by Nakamura (US PG Pub. 2002/20023343; "Nakamura").

The Applicants have considered the Examiner's remarks and, while believing that the rejection can be successfully traversed, have elected to amend the claims to more clearly state the subject matter claimed.

Amended Claim 1 recites, *inter alia*, an array of capacitive elements at least partially surrounding the electrical device, wherein the capacitive elements of the array are disposed adjacent to two adjoining sides of the electrical device.

To the extent that the Examiner may assert that any grouping of the capacitors shown in FIG. 1 would constitute an array of capacitors, such an array would not meet the limitation of amended Claim 1 that capacitive elements of the array are disposed adjacent to two adjoining sides of the electrical device. As such, amended Claim 1 is not anticipated, and is allowable over the reference. Claims 3 and 8-10, are allowable, without more, as claims dependent on an allowable claim.

**Withdrawn Claims**

The Applicant respectfully submits that Claim 1 is a generic claim for at least the withdrawn claims dependent thereon.

**Conclusion**

Claims 1, 3 and 8-10 are pending.

For at least the reasons presented herein and in view of the amendments, the Applicants respectfully submit that the application is in condition for allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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